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JAN 22 2002

**OFFICE OF PETITIONS
ON PETITION**

In re Application of
Huang, et al.
Application No. 09/240,833
Filed: 1 February, 1999
Attorney Docket No. 147268.00261

This is a decision on the petition styled as "Petition for Withdrawal of Abandonment Under 37 C.F.R. §1.181" filed on 30 April, 2001, and more appropriately treated as a request for the withdrawal of the holding of abandonment under the provisions of 37 C.F.R. §1.181.¹

The petition is **DISMISSED**.²

NOTES:

(1) Any request for reconsideration of this decision under 37 C.F.R. §1.181 (as to withdrawal of the holding of abandonment) or an alternative request for relief under 37 C.F.R. §1.137(b) (as to unintentional delay) must be submitted within two (2) months from the mail date of this decision. Extensions of time under 37 C.F.R. §1.136(a) are permitted.

The reconsideration request should include a cover letter entitled "Renewed Petition under 37 C.F.R. §1.181 and Petition under 37 C.F.R. §1.137(b)";

(2) Thereafter, there will be no further reconsideration of this matter

(3) Moreover, it appears that while a copy of a Power of Attorney has been attached to

¹ The regulations at 37 C.F.R. §1.181 provide, in pertinent part:

§1.181 Petition to the Commissioner.

(a) Petition may be taken to the Commissioner: (1) From any action or requirement of any examiner in the *ex parte* prosecution of an application which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court; (2) In cases in which a statute or the rules specify that the matter is to be determined directly by or reviewed by the Commissioner; and (3) To invoke the supervisory authority of the Commissioner in appropriate circumstances. * * *

(b) Any such petition must contain a statement of the facts involved and the point or points to be reviewed and the action requested. Brief or memoranda, if any, in support thereof should accompany or be embodied in the petition; and where facts are to be proven, the proof in the form of affidavits or declaration (and exhibits, if any) must accompany the petition.

(c) When a petition is taken from an action or requirement of an examiner in the *ex parte* prosecution of an application, it may be required that there have been a proper request for reconsideration (§1.111) and a repeated action by the examiner. The examiner may be directed by the Commissioner to furnish a written statement, within a specified time, setting forth the reasons for his decision upon the matters averred in the petition, supplying a copy thereof to the petitioner.

(d) Where a fee is required for a petition to the Commissioner the appropriate section of this part will so indicate. If any required fee does not accompany the petition, the petition will be dismissed. * * *

(f) Except as otherwise provided in these rules, any such petition not filed within 2 months from the action complained of, may be dismissed as untimely. The mere filing of a petition will not stay the period for reply to an Examiner's action which may be running against an application, nor act as a stay of other proceedings. * * *

² Pursuant to Petitioner's authorization, the \$130.00 petition fee is charged to Deposit Account 50-1682.

the instant petition, no NOTICE OF CHANGE OF ADDRESS and REVOCATION/ POWER OF ATTORNEY has been formally filed of record.

That condition is in contrast to requisite Office practice requiring proper notification of change of address, and such failure of practice does not reflect the requisite diligence of practice before the Office so as to demonstrate the care given to one's most important business affairs.³

BACKGROUND

The record indicates that:

- Petitioner failed to reply timely a non-final Office action mailed on 30 January, 2001, and due (absent extension of time) on or before 30 April, 2001;
- the application went abandoned at midnight on 30 April, 2001;
- Notice of Abandonment was mailed on 25 September, 2001;⁴ and
- Petitioner supplies no documentary evidence in support of his petition, and has as of this writing failed to file a reply to the Office action in question.⁵

STATUTES, REGULATIONS AND ANALYSIS

Congress has authorized the Commissioner to "revive an application if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994).⁶ And the regulations at 37 C.F.R. §1.137(a) and (b) set forth the requirements for a petitioner to revive a previously unavoidably⁷ or unintentionally, respectively, abandoned application under this congressional grant of authority .

³ See: Ex parte Pratt, 1887 Dec. Comm'r Pat. 31 (Comm'r Pat. 1887); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (Comm'r. Pat. 1913): In the context of ordinary human affairs the test is such care as is generally used and observed by prudent and careful persons in relation to their most important business.

⁴ Petitioner incorrectly cites the date as 24 September, 2001.

⁵ In order to expedite Petitioner's filing of a proper reply herein, a copy of the 30 January, 2001, Office action is enclosed.

⁶ 35 U.S.C. §133 provides:

35 U.S.C. §133 Time for prosecuting application.

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

⁷ The language of 35 U.S.C. §133 and 37 C.F.R. §1.137(a) is clear, unambiguous, and without qualification: the delay in tendering the reply to the outstanding Office action, as well as filing the first petition seeking revival, must have been unavoidable for the reply now to be accepted on petition. Therefore, by example, an unavoidable delay in the payment of the Filing Fee might occur if a reply is shipped by the US Postal Service, but due to catastrophic accident, the delivery is not made.

By contrast, unintentional delays are those that do not satisfy the very strict statutory and regulatory requirements of unavoidable delay, and also, by definition, are not intentional. Therefore, by example, an unintentional delay in the reply might occur if the reply and transmittal form are to be prepared for shipment by the US Postal Service, but other pressing matters distract one's attention and the mail is not timely deposited for shipment.

Moreover, the courts have determined the construct for properly supporting an allegation of non-receipt of an Office action in seeking withdrawal of a holding of abandonment.⁸

Allegation of Non-Receipt of Office Action

Petitioner cites as the alleged basis for his request that the Office withdraw the holding of abandonment a statement that Petitioner did not receive Office action in question.

However, there is no documentation submitted in support of this allegation, save Petitioner's statement. There are no copies of the mail-receipt log(s); no description of Petitioner's procedures for collecting and reviewing in-coming mail and or statement from any staff support personnel in Petitioner's who handle those responsibilities:

- (1) the method used for recording/tracking incoming and outgoing communications regarding applications in general and this application in particular, and
- (2) the manner in which this application was in fact handled by the applicant and/or those acting on behalf of the applicant.

Moreover, there are no copies of Petitioner's office documents/records indicating:

- what material was received on what date,
- what was received in the weeks after mailing of the Notice, and
- evidencing the difference in Petitioner's records as to the receipt of the Notice of Abandonment as contrasted with the alleged non-receipt of the January 2001 Office action.

Therefore, Petitioner has failed to:

- (a) support a petition for withdrawal of the holding of abandonment, and/or
- (b) seek relief for unintentional delay.⁹

Petitioner's further failure to cure timely these defects may reasonably be found to be intentional delay. Such a finding would be an absolute bar to revival.

Therefore, the contention that the Office action was not received is not supported in the record. That failure fails to satisfy the burdens set forth in Delgar v. Schulyer.

Withdrawal of the holding of abandonment is not proper.

⁸ See: Delgar v. Schulyer, 172 USPQ 513 (D.D.C. 1971).

⁹ See: Alternative Venue, below.

ALTERNATIVE VENUE

Lacking the documentation discussed above, Petitioner likely is unable to make a showing necessary for a withdrawal of the holding of abandonment, and Petitioner's only alternative to irretrievable abandonment is to:

- file a petition and fee as set forth at NOTE 1, above at page 1, under 37 C.F.R. §1.137(b), and
- state therein that "the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. §1.137(b) was unintentional."

Thus, Petitioner may wish to supplement his petition to plead alternatively under 37 C.F.R. §1.137(b) wherein the "showing" burden is much less onerous.

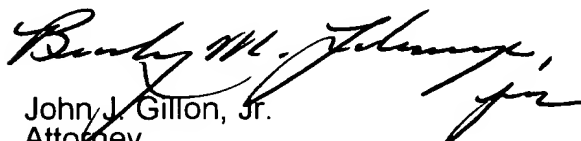
Further correspondence with respect to this matter should be addressed as follows:

By mail: Commissioner of Patents and Trademarks
Box DAC
Washington, D.C. 20231

By FAX: (703) 308-6916
Attn: Office of Petitions

By hand: Crystal Plaza Four, Suite CP4-3C23
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Telephone inquiries should be directed to John J. Gillon, Jr., Attorney, Office of Petitions, at (703) 305-9199.



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